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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,381	04/25/2002	Didier Chomier	022701-954	9708

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EXAMINER

NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,381

Applicant(s)

CHOMIER ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims

1. Claims 1-24 are pending.

Withdrawal of Objection

2. The objection to claim 6 and its potential allowability are withdrawn in order to apply the new grounds of rejection below.

Rejections Withdrawn

3. The 35 USC 102 rejection of claims 1-4, 7-12, 14-15 and 20-21 as anticipated by McCollough et al (US 5,049,349), as set out in section 4 of the office action of 02 May 2003 (Paper No. 7), is withdrawn in view of applicants' amendments and arguments in the response dated 17 July 2003 (Paper No. 8).
4. The 35 USC 103 rejection of claims 5, 13 and 16-19, as recited in section 6 of Paper No. 7, is withdrawn in view of the amendments and arguments in Paper No. 8.

New Rejections

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What does "profile which is the conjugate of the concave space" mean? Please clarify the claims.

Art Unit: 1772

7. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the limitation "shield transfer device" in line 1. There is insufficient antecedent basis for this limitation in the claim or in claim 16, from which it depends:

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-2, 4-5, 7, 9-10, 12, 15, 18 and 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al (US 5,456,957).

Jackson teaches composites for automobile trim members that comprise an elastic surface sheet **16** and a hollow thermoplastic injection molded backing material **18** (Figure 2 and col. 3, lines 11-22). The surface sheet is thermoplastic (col. 3, line 23-24) and the backing is thermoplastic (col. 3, lines 46-56). The molded member may be U shaped (Figure 6).

10. Claims 1, 4, 6-10, 13-15, 18 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldbach et al (US 5,190,803).

Goldbach teaches shell/rib composites for use as front and rear parts of cars (col. 1, lines 53) or construction elements (col. 1, line 16). The shell is made of metal

Art Unit: 1772

(col. 1, lines 37-43) or thermoplastics (col. 1, lines 43-51). The ribs are made of injection molded plastic (col. 1, lines 32-36) that may be polyamide (col. 3, lines 23-26). The composites may be tubular (Figures 2 and 3), U shaped (Figure 2) and have ribs in the corners (Figure 2).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 16-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson.

Jackson is discussed above. It fails to teach the uses of claims 16-17 and 19.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the composites of Jackson to make articles for any intended use.

It has been held that a recitation with respect to the manner in which a claimed invention is intended to be employed does not differentiate the claimed invention from prior art satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

13. Claims 16-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldbach.

Goldbach is discussed above. It fails to teach the uses of claims 16-17 and 19.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the composites of Goldbach to make articles for any intended use.

It has been held that a recitation with respect to the manner in which a claimed invention is intended to be employed does not differentiate the claimed invention from prior art satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson and Goldbach.

Both patents are discussed above.

In the absence of convincing objective evidence to the contrary, it would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ any conventional technique to secure the inner reinforcing materials in the composites of Jackson and Goldbach.

The process by which the inner element is placed within the structure is deemed matter of engineering choice and does not distinguish the article of claim 11 from the articles suggested by the teachings of Jackson and Goldbach.

Citation as of Interest

15. Mirmiran et al (US 5,599,599) teaches concrete composite structures with pultruded plastic ribs therein. See Figure 1A and col. 3, line 51 through col. 2, line 23.

Art Unit: 1772

Response to Arguments

16. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.



S. M. Nolan
Patent Examiner
Technology Center 1700

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